

Application No. 09/423,037  
Amendment dated December 10, 2008  
Reply to Office Action of October 16, 2008

Docket No.: ASZD-P01-228

### **REMARKS**

Claims 1 and 3-22 are pending in the subject application. Claims 5, 6, and 14-22 are withdrawn as being directed to a non-elected invention. Claims 2 and 23 are cancelled. Applicants have amended claim 1 and respectfully request reconsideration in view of the following remarks. No new matter has been added.

#### **Claim Rejection under 35 U.S.C. § 112 – Written Description**

Claims 1, 3, 4, and 7-13 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection to the extent it is maintained over the claims as amended.

The recitation of the term “NR box” apparently gave rise to the Examiner’s rejection, under the premise that this term would have been understood by one of skill in the art to refer to a sequence LXXLL. While Applicants take no position on this conjecture, Applicants have replaced this term with the specific sequence referred to in the specification, namely XLXXLLLXXX, thus eliminating any possible ambiguity. Although this sequence is not explicitly recited in the instant specification, it is described inherently at page 1, lines 24-25, where the specification makes direct reference to the NR box described in Figure 3D of Le Douarin. This figure, reproduced in the Office Action, clearly delineates a 10-amino-acid region as being the “NR box”, and the common pattern of conserved leucine residues is indicated by boxes around the L’s representing those residues. Accordingly, one of skill in the art would immediately recognize that the “NR box” indicated by the reference in the specification is the sequence XLXXLLLXXX.

The NR box is again referenced in the specification in the first full paragraph of page 8. This passage indicates that the NR box of Le Douarin does not disclose the subject signature motif (e.g., there is no disclosure that the X residues at the beginning and end of the NR box may be omitted, and there is no indication that the fourth L residue is not required), and points out that, of the 39

Application No. 09/423,037  
Amendment dated December 10, 2008  
Reply to Office Action of October 16, 2008

Docket No.: ASZD-P01-228

signature motif-containing sequences disclosed in Figures 3A and 4, only four have an NR box. As can be seen from Figure 3A, RIP140 has two NR boxes of the sequence XLXXLLLXXX (379-389 and 935-945), and FIY1 and Trip3 have one each. No sequences in Figure 4 have such NR boxes. This exercise merely confirms to the skilled artisan that the "NR box" to be distinguished from the instant invention is the sequence XLXXLLLXXX. Plainly, if the specification used the term "NR box" to refer to the sequence LXXLL, as the Office Action asserts, an NR box would have been present in all 39 sequences. This proposed interpretation is plainly at odds with the use of the term "NR box" in the specification, and thus cannot have been the sequence indicated by the term "NR box" as it is used in the specification. Rather, the term clearly refers to the sequence XLXXLLLXXX.

It is well settled that "[a]n adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention." See MPEP 2163 II.3(a) and cases cited therein. Specifically, "each claim limitation much be expressly, implicitly, or inherently supported in the originally filed disclosure." MPEP 2163 II.3(b). Although the sequence of the NR box is not expressly recited in the specification, it is sufficient if a person of ordinary skill in the art would have understood that the description requires that sequence, or that the sequence is an inherent property of a thing disclosed in the specification. MPEP 2153.07(a). Given the clear direction in the instant specification to a specific portion of a specific feature of a specific reference (the NR box of Figure 3D of Le Douarin), and the manner in which this sequence operatively describes exactly four of the sequences in Figures 3A and 4 as indicated in the instant specification, it would have been clear to the skilled artisan that no other sequence could have been intended, and that the NR box described in the specification is essentially synonymous with the sequence XLXXLLLXXX. Accordingly, no new matter is added by replacing the term "NR box" with the specific sequence that one of skill in the art would understand was meant by that term.

Furthermore, the passage on page 8 clearly conveys Applicants' recognition that although some sequences that have a signature sequence B<sup>1</sup>XXLL have an NR box, Applicants conceived of that set of sequences that have a signature sequence B<sup>1</sup>XXLL but do not have an NR box as

Application No. 09/423,037  
Amendment dated December 10, 2008  
Reply to Office Action of October 16, 2008

Docket No.: ASZD-P01-228

disclosed by Le Douarin. Accordingly, not only is it clear what sequence was indicated by the reference to the NR box of Le Douarin, but that Applicants were in full possession of the set of sequences comprising a signature sequence B'XXLL but lacking such an NR box. Accordingly, the claims as amended fully comply with the written description requirement. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejection under 35 U.S.C. § 112 – Enablement

Claims 1, 3, 4, and 7-13 are rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully traverse this rejection to the extent it is maintained over the claims as amended.

This rejection is premised upon the recitation of the term “NR box” in claim 1, which term has been removed as described above. Applicants submit that as it is clear that a sequence can comprise a signature motif B'XXLL without comprising the sequence XLXXLLXXX, the issues raised by the Examiner are moot, and one of skill in the art could readily practice the presently claimed invention throughout its scope. Reconsideration and withdrawal of this rejection are respectfully requested.

Claim Rejections under 35 U.S.C. § 103(a)

Applicants note with appreciation the Examiner's withdrawal of rejections under this section. Applicants submit that the rationale and the conclusion set forth in the Office Action are undisturbed by the present amendment to claim 1.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-

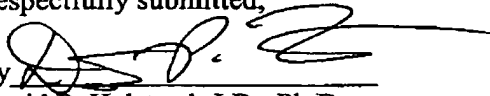
Application No. 09/423,037  
Amendment dated December 10, 2008  
Reply to Office Action of October 16, 2008

Docket No.: ASZD-P01-228

7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to Deposit Account No. 18-1945, under Order No. ASZD-P01-228 from which the undersigned is authorized to draw.

Dated: December 10, 2008

Respectfully submitted,

By 

David P. Halstead, J.D., Ph.D.

Registration No.: 44,735

ROPES & GRAY LLP

One International Place

Boston, Massachusetts 02110

(617) 951-7000

(617) 951-7050 (Fax)

Attorneys/Agents For Applicant